REMARKS

In a final Office Action dated11 July 2006, the Examiner rejects claims 1, 5-7, 11-13, 17-21, and 25-30 (all pending claims). In response to the final Office Action, Applicants amend claims 1, 7, 13, and 19. Applicants would also like to respectfully traverse the rejections. In light of the amendments, Applicants respectfully request that this application be allowed.

The Examiner rejects claim 1 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,201, 791 B1 issued to Bournas (Bournas). In order to maintain a rejection the Examiner has the burden of providing evidence of prima facie obviousness. See MPEP §2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed element. Id. The Examiner has failed to provide evidence of each and every claimed element of claim 1.

Amended claim 1 recites "establishing a routing path for a session to be tested wherein said routing path is a static IP route;" and "counting, by a packet count unit at a second end of said route, received packets at the packet count unit." Bournas does not teach either of these limitations. In fact, the Examiner admits that Bournas does not teach that the IP routing path is static. However, the Examiner states that the path can be arranged this way as a design choice. This is a mere assertion and is not evidence of establishing a static IP path. If the Examiner is relying on the prior art to provide such evidence. Applicants respectfully request the Examiner provide such evidence in the

prior art as required under MPEP § 2144.03 and give Applicants an opportunity to respond to such evidence. **The Examiner still has not provided evidence that such an assertion is true.** Thus, this rejection must be removed.

The Examiner has also not provided a teaching of counting, by the counting unit, received packets at the packet count unit. Bournas does not teach this limitation. Instead Bournas, uses acknowledge statements received at the sending node to determine the number of packets received at the second or client end. See Generally, Abstract. See also Col. 6, lines 43-Col. 7, line 8. Specifically, Bournas states When N test packets have been transmitted, step 512 initiates a Retransmission Timer to a value that is much greater than the expected time to receive an acknowledgement for the last test packets. If the timer expires before all of the acknowledgments are received, then an entry is made to the program of 700…" This clearly shows that Bournas does the counting at the sending node and not at the receiving node at the second end as recited in amended claim 1. In amended claim 1, the counting unit in the second node does the counting. Thus, eliminating the possibility of the acknowledgment being dropped and therefore giving an inaccurate peak value. Thus, Applicants respectfully request that the rejection of claim 1 be removed and amended claim 1 be allowed.

Furthermore, the Examiner has **still** failed to provide a motivation to establish a Static IP path as recited in the claim. The Examiner merely asserts this as a design choice. However, the Examiner provides no evidence of a reason to make such design choice. Unless, the Examiner provides such a motivation, the rejection must be removed.

For the above reasons, Applicants respectfully request that the rejection of claim 1 be removed and amended claim 1 be allowed.

Claims 5-6 are dependent upon amended claim 1. Thus, claims 5-6 are allowable for the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejections of claims 5-6 be removed and claims 5-6 be allowed.

Amended claim 7 recites a program storage device that stores instructions for providing the method of amended claim 1. Thus, amended claim 7 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejection of claim 7 be removed and amended claim 7 be allowed.

Claims 11-12 are dependent upon amended claim 7. Thus, claims 11-12 are allowable for the same reasons as amended claim 7. Therefore, Applicants respectfully request that the rejections of claims 11-12 be removed and claims 11-12 be allowed.

Amended claim 13 recites an apparatus for performing the method of amended claim 1. Thus, amended claim 13 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejection of claim 13 be removed and amended claim 13 be allowed.

Claims 17-18 are dependent upon amended claim 13. Thus, claims are allowable for the same reasons as amended claim 13. Therefore, Applicants respectfully request that the rejections of claims 17-18 be removed and claims 17-18 be allowed.

Amended claim 19 recites a system that provides the method of amended claim 1. Thus, amended claim 19 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejection of claim 19 be removed and amended claim 19 be allowed.

Claims 20-21 and 25-30 are dependent upon amended claim 19. Thus, claims 20-21 and 25-30 are allowable for the same reasons as amended claim 19. Therefore, Applicants respectfully request that the rejections of claims 20-21 and 25-30 be removed and claims 20-21 and 25-30 be allowed.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,
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